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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/536,366	03/27/2000	Christopher J. Edge	53492USA02 (EKC 90218B)	3630

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EXAMINER

BRIER, JEFFERY A

ART UNIT

PAPER NUMBER

2628

DATE MAILED: 11/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/536,366

Applicant(s)

EDGE ET AL.

Examiner

Jeffery A. Brier

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 September 2006 and 31 August 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 33-37, 47-53 and 60-67 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 33-37, 47-53 and 60-67 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 8/31/2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. The amendments filed on 8/31/2006 and 9/14/2006 have been entered. The 8/31/2006 replacement drawing sheet overcomes the objection of figure 5 set forth in the office action mailed on 4/28/2006 at paragraph 11. The 8/31/2006 amendments to the specification overcome the objection to the specification set forth in the office action mailed on 4/28/2006 at paragraph 10. The amendments to the claims overcomes the rejection set forth in the office action mailed on 4/28/2006 at page 7 concerning claims 33, 36, 37, 47-53, and 60-64. However, the remaining rejections under 35 USC 112 first paragraph have not been overcome.

Information Disclosure Statement

2. Enclosed are copies of the 9/20/2004 and 9/14/2006 initialed PTO-1449s.

Response to Arguments

2. Applicants arguments filed 8/31/2006 concerning the 35 USC 112 first paragraph rejection at pages 11 and 12 have been fully considered and with the exception of the rejection set forth at page 7 concerning claims 33, 36, 37, 47-53, and 60-64 the arguments are not persuasive because a preliminary amendment for an application filed before September 21, 2004 is not a part of the disclosure unless it is referred to by the first executed oath or declaration. Since this applications declaration does not refer to the preliminary amendment then the preliminary amendment cannot be used as basis

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for the rejected claims. See MPEP 714.01(e) Rev. 5 August 2006 page 700-246. Thus, the 35 USC 112 first paragraph rejection set forth at pages 4-7 is maintained except for the above noted exception.

3. Applicants arguments filed 8/31/2006 concerning the 35 USC 112 second paragraph rejection at page 12 last paragraph lines 1-6 have been fully considered and they are not persuasive because 35 USC 112 second paragraph states "The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.". Thus, the claims need to distinctly point out the invention in order for the public to understand that which is covered by the claims.

4. Applicants arguments filed 8/31/2006 concerning the 35 USC 112 second paragraph rejection at page 12 last paragraph lines 6-9 have been fully considered and they are not persuasive because as discussed above the preliminary amendment does not provide support for the claims since the requirements of MPEP 714.01(e) Rev. 5 August 2006 at page 700-246 was not followed by applicant.

5. Applicants arguments filed 8/31/2006 concerning the 35 USC 101 rejection at page 11 have been fully considered and they are not persuasive because the amendments to claims 33-35 and 47 limiting these claims to a system of software components executed by one or more computers and claim 51 limiting this claim to a method implemented at least in part by one or more computers does not give these claims a useful, concrete, and tangible result.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 33-37, 47-53, and 60-67 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

7. Claims 33-37, 47-53, and 60-67 are not directed to a useful, concrete, and tangible result. Similarly these claims are directed to manipulating abstract processes.

State Street Bank & Trust Co. v. Signature Financial Group Inc. (CA FC) 47 USPQ2d

1596, 1603 (7/23/1998). AT&T Corp. v. Excel Communications Inc. (CA FC) 50

USPQ2d 1447. On page 1603 first paragraph the CAFC wrote in State Street:

Under *Benson*, this may have been a sufficient indicium of nonstatutory subject matter. However, after *Diehr* and *Alappat*, the mere fact that a claimed invention involves inputting numbers, calculating numbers, outputting numbers, and storing numbers, in and of itself, would not render it nonstatutory subject matter, unless, of course, its operation does not produce a "useful, concrete and tangible result." *Alappat*, 33 F.3d at 1544, 31 USPQ2d at 1557. 7

On page 1603 paragraph labeled [4] the CAFC wrote:

[4] The question of whether a claim encompasses statutory subject matter should not focus on which of the four categories of subject matter a claim is directed to -- process, machine, manufacture, or composition of matter-- but rather on the essential characteristics of the subject matter, in particular, its practical utility. Section 101 specifies that statutory subject matter must also satisfy the other "conditions and requirements" of Title 35, including novelty, nonobviousness, and adequacy of disclosure and notice.

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See *In re Warmerdam*, 33 F.3d 1354, 1359, 31 USPQ2d 1754, 1757-58 (Fed. Cir. 1994).

Claims 47-50 are means plus function claims. Since the specification defines the "means" for performing the function to be a software program then these claims are claiming a software program per se rather than a computer system performing the claimed functions. The claimed system of software components executed by one or more computers does not claim a computer system performing the claimed functions but rather still claims a software program per se.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

9. Claims 34-37, 48-53, and 60-67 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 34:

Independent claim 34 claims "the source device profile contains raw spectral data that characterizes a source device, and the destination device profile contains raw spectral data that characterizes a destination device". Page 16 lines 18-22 states

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"Additionally, the device profile 302 optionally stores the raw spectral data used to construct the device profile 302. The raw spectral data allows subsequent construction of more accurate device profiles 302, e.g., if ICC specifications change." Thus, the claim limitation "characterizes" is not clear from the definition given for the raw spectral data in the specification and the specification does not convey "characterizes". Since the specification describes device profile 302 but not the claimed source device and destination device, the specification does not convey the claim limitations of this claim.

Claim 35:

Independent claim 35 claims "color transformer that generates a color map ... based on the converted coordinates and user preferences specified by a user independently of the source and destination device profiles ... wherein the user preference include color conversion preferences, wherein the source device profile defines ... color space, and wherein the destination device profile define ... color space". The specification describes at page 15 lines 19-22 describes the user preferences as "The color management system 200 receives user preferences from an input 218 to determine how to configure the color transformer 214." while the claim claims "user preferences specified by a user independently of the source and destination device profiles" are used in generating the color map. It appears the specification only conveys the user preferences configures the color transformer 214. Thus, the specification does not convey the claim limitations of this claim.

Claims 36 and 37:

Claims 36 and 37 claim the color map “includes” a look-up table or mathematical expression. Page 20 lines 3-11 of the specification states the color map “is, for example, a mathematical expression or a look-up table”. A color map that “include” is different than a color map the “is”. Thus, the specification does not convey these claim limitations.

Claims 63 and 66:

Both of claims 63 and 66 claim “the source and destination profile interpreters are configured as removable plug-in modules for use by the color transformer”. While applicants specification at page 13 lines 3-6 states: “The device profile interpreters 202 and 208 can be configured using any of a variety of approaches. For example, plug-in software modules can be used to configure the device profile interpreters 202 and 208.”. Thus, the specification does not state two critical claimed limitations 1) “removable plug-in modules” and 2) “are configured as removable plug-in modules”. The specification describes using a plug-in software module to configure the source and destination profile interpreters but does not convey “source and destination profile interpreters are configured as removable plug-in modules”. A software module that configures a device is different than a device that is a software plug-in software module.

Claims 62 and 65:

Both claims 62 and 65 claim the “color transformer adjusts the source and destination device profiled interpreters based on user preferences” while the

specification does not convey this claim limitation, see page 16 first paragraph and page 35 line 7 to page 36 line 13.

Claims 64 and 67:

Both claims 64 and 67 claim “the source and destination device profile interpreters are configured based on white-and black-point parameters while the specification at page 12 lines 8-15 describes “interpreters 202 and 208 are optionally configured to include white- and black-point parameters”. The claim claims the interpreters are configured based upon the parameters while the specification describes the interpreters include the parameters. To configure based on parameters is different than configuring by including parameters.

Claims 48, 49, 52, 53, 60, and 61 claim user preferences include illuminant functions (claims 48, 52, 60) or observer functions (claims 49, 53, 61). Page 12 line 20 to page 13 line 2, page 15 lines 15-22, and page 18 lines 5-9 and lines 12-14 describes illuminant and observer functions but does not describe the user preference include illuminant functions or observer functions. Additionally the parent claims claim the user preference is used to define relationships and the specification does not describe this as seen at the above cited sections of the specification.

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10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claims 33-37, 47-53, and 60-67 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 33, 36, 37, 47-53, and 60-64:

Independent claims 33, 47, and 51 broadly claim to reduce color error between the converted coordinates from the source and destination device profile interpreters and does not claim how this is performed. These claims also broadly claim the color transformer adjusts coordinates in the destination device color space to reduce the color error which does not specify how the process in the first wherein clause reduces the color error. Thus, the process for reducing the color error is not definite. All prior art system can be broadly characterized as "reducing color error". It is also not clear if the "converted coordinates" at lines 11-12 are the same coordinates adjusted at line 16 or different coordinates. Thus, the metes and bounds of these claims are unclear.

Independent claim 34 claims "the source device profile contains raw spectral data that characterizes a source device, and the destination device profile contains raw spectral data that characterizes a destination device". Page 16 lines 18-22 states "Additionally, the device profile 302 optionally stores the raw spectral data used to construct the device profile 302. The raw spectral data allows subsequent construction of more accurate device profiles 302, e.g., if ICC specifications change." Thus, the

claim limitation "characterizes" is not clear from the definition given for the raw spectral data in the specification. Thus, the metes and bounds of this claim are unclear.

Independent claim 35 claims "color transformer that generates a color map ... based on the converted coordinates and user preferences specified by a user independently of the source and destination device profiles ... wherein the user preference include color conversion preferences, wherein the source device profile defines ... color space, and wherein the destination device profile define ... color space". It is not clear if the user preferences include the source device profile and the destination device profile since the specification only describes at page 15 lines 19-22 the user preferences as "The color management system 200 receives user preferences from an input 218 to determine how to configure the color transformer 214." while the claim claims "user preferences specified by a user independently of the source and destination device profiles" are used in generating the color map. Thus, the metes and bounds of this claim are unclear.

12. A prior art rejection cannot be made because the metes and bounds of the claims are not definite and because the specification does not support the claims. Thus, an indication of allowability would be premature. In re Steele, 305 F.2d 859,134 USPQ 292 (CCPA 1962) (it is improper to rely on speculative assumptions regarding the meaning of a claim and then base a rejection under 35 U.S.C. 103 on these assumptions).

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

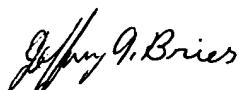
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffery A Brier whose telephone number is (571) 272-7656. The examiner can normally be reached on M-F from 7:00 to 3:30. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Razavi, can be reached at (571) 272-7664. The fax phone Number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Jeffery A. Brier". The signature is written in a cursive style with a large, stylized initial "J".

Jeffery A Brier
Primary Examiner
Division 2628